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| In re Application of: | : | |
| KOMIYAMA, Shunji, et al. | : | DECISION ON RENEWED |
| U.S. Application No.: 10/576,084 | : | PETITION |
| PCT No.: PCT/JP04/15258 | : | (37 CFR 1.47(a)) |
| Int'l Filing Date: 15 October 2004 | : | |
| Priority Date: 17 October 2003 | : | |
| Atty Docket No.: 2593-0164PUS1 | : | |
| For: POLYMER ALLOY, CROSSLINKED | : | |
| OBJECT AND INDUSTRIAL PART | : | |

This decision is issued in response to applicants' renewed petition under 37 CFR 1.47(a) and filed 13 August 2007 and the refund request filed 12 September 2007. No additional petition fee is required.

BACKGROUND

The procedural background for the present application was set forth in the decision mailed herein on 14 June 2007, which dismissed applicants' petition under 37 CFR 1.47(a) for failure to satisfy the requirements of a grantable petition. Specifically, applicants had failed to provide an adequate showing that the non-signing inventor has refused to execute the application or cannot be located after diligent effort.

On 13 August 2007, applicants filed the renewed petition and refund request considered herein.

DISCUSSION

A. Refund Request

Applicants' 12 September 2007 refund request seeks a refund of the \$130 fee charged to applicants for failure to provide an English translation of the international application within thirty months of the priority date.

The previous decision noted that applicants had timely submitted an English translation of the international application, and it stated that applicants' previous submission of \$130 as the fee for late filing of the English translation would be treated as payment of the required surcharge for filing the oath or declaration later than thirty months after the priority date. However, a review of the application file reveals that applicants' Deposit Account was charged

at the time for both the declaration surcharge and an additional processing fee for the English translation. As a result, applicants' have now submitted the required declaration surcharge and have been charged twice for the processing fee for late submission of an English translation, a fee which applicants here are not required to pay.

Based on the above, a refund of the two processing fees charged to applicants for purportedly filing the English translation later than thirty months after the priority date is appropriate. Accordingly, a refund of \$260 will be credited to applicants' Deposit Account.

B. Renewed Petition Under 37 CFR 1.47(a)

In the present petition, applicants assert that the non-signing inventor cannot be located after diligent effort. Section 409.03(d) of the MPEP states the following concerning such cases:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, the renewed petition supplements the original petition by providing an explanation as to the meaning of the Japanese postal service indication of "undeliverable" on the envelope mailed to the non-signing inventor, as required by the previous decision. However, the evidence of record is still insufficient to show that the non-signing inventor cannot be located after diligent effort. Applicants have provided firsthand evidence that the inventor is no longer at his last known address, and that an inquiry with a public telephone directory service did not provide a current telephone number for the inventor. However, applicants have not provided acceptable evidence that any further efforts were made to locate the non-signing inventor. The statement of Hiroshi Yagi submitted with the renewed petition states that he has "subsequently been unable to determine the current address" of the non-signing inventor; however, Mr. Yagi does not provide any details as to what such further efforts entailed, nor has any documentary support of such further efforts been provided. Mr. Yagi's statement therefore fails to "fully describe the exact facts which are relied upon to establish that a diligent effort was made," as required by the

MPEP. It is noted that, as indicated in the MPEP, a showing of a diligent effort to locate a non-signing inventor should include, but not be limited to, internet searches (with the results of such internet searches being made of record).

The present showing of a mailing to a non-current address and a single inquiry with a public telephone directory service is not considered an adequate showing that a diligent effort has been made to locate the non-signing inventor. Accordingly, the final element for a grantable petition under 37 CFR 1.47(a) remains unsatisfied.

CONCLUSION

Applicants' refund request is **GRANTED**.

Deposit Account No. 02-2448 will be credited with a refund of the two processing fees charged for the purported failure to file an English translation of the international application within thirty months of the priority date (a total of \$260).

Applicants' renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy the remaining element of a grantable petition, as discussed above and in the MPEP, that is, the firsthand and documentary evidence required to demonstrate that a diligent effort has been made to locate a current address for the non-signing inventor and obtain his signature at such address.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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